REMARKS

Claims 1-44 are pending in the application.

Specification Objections

The specification is objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. Applicant respectfully traverses this rejection.

The specification and the drawings disclose various computer products that support claims 33-41. For example, Figures 1, 2 and 3 disclose various devices that are computer products. These products may run computer software programs, such as iChat™, AIM™, etc. see for example, Specification, page 10, ¶¶[0032]-[0033]. The hardware structures, e.g., processors, memory, etc, of the peers are described in page 10, ¶[0032] and is inherently present, as would be known to those skilled in the art upon a reading of the present disclosure, in the devices illustrated in Figure 1. Therefore, based upon the exemplary embodiments disclosed in the specification, those skilled in the art would find, explicitly and/or implicitly, all of the elements of the computer program products comprising computer-readable medium, as called for by claims 33-41.

Claims Rejections Under 35 U.S.C. 112

The Examiner rejected claims 4, 5 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. Applicant respectfully traverses this rejection. Applicant respectfully asserts that the use of the term "substantially" does not render the term indefinite. The Examiner rejects to claims 4, 5 by objection to the use of the language "substantial," which the Examiner claims is a relative term and thus, allegedly causes these claims to be indefinite. As the court indicates in *Andrew Corp. v. Gabriel Electronics*, an "'imprecise claim limitation, such as the phrase 'about 100% per second'' does not impart invalidity to the claims, but is to be considered in

determination of infringement." 847 F. 2d 819, 821-22 (C.A. Fed. 1988). The same reasoning applies to the term "substantially," which even though may or may not be somewhat imprecise, is not indefinite and would be valid. The imprecision of the term in question is negated and made understandable when those skilled in the art view claims 4 and 5 in the context of the entire claim and the specification. For example, because the data transfer in claims 4 and 5 takes place over a network, there is some inherent latency involved in the data transmission. As such, the resulting time lapse may mean the stream is not in perfect sync with the portion of the active content currently active to the first application module. Therefore, claims 4, 5 are not indefinite and are allowable for at least the reasons cited herein. Applicant respectfully requests this rejection be withdrawn.

Claims Rejections Under 35 U.S.C. 101

The Examiner rejected claims 1-21, 42-44 under 35 U.S.C. 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Examiner rejected claim 1 for having recited a system comprising a sender peer and a recipient peer, wherein each peer comprising modules. The Examiner asserts that because the Specification recites that "in general, a peer is some type of computing device (physical or virtual)," the claim is allegedly strictly software due to the reference to the "virtual" description. However, Examiner's own assertion indicates that the disclosure in the Specification recites that the computing device may be physical or virtual. Further, virtual components may also be linked with physical components. Further, the Examiner's recitation of the Microsoft Computer Dictionary does not reference any type of a date and it is impossible to determine whether this reference relates to any information that was available at the time of filing of the present

application. Nevertheless, the Specification clearly describes that a peer may be a "physical device." Therefore, claim 1 does not strictly reference a software structure.

Regarding rejection of claim 42, the Examiner asserts that "recipient chat module" can be a software module and, thus, not statutory subject matter. However, this is not the case since the claim specifically calls for the recipient chat module comprising a communications module and a client module, clearly, these modules include embodiments that have physical entities and, thus, the recipient chat module is clearly not solely a software module. Therefore, claim 42 of the present invention includes statutory subject matter. Accordingly, claim 42 of the present invention includes statutory subject matter and is allowable for at least the reasons cited herein.

Regarding the Examiner's rejections of claims referencing computers, claims 1-21 clearly recite a <u>system</u> for sharing information about an active content of a sender peer with a recipient peer. The system of claim 1 includes a sender peer that comprises an application module and a chat module. Thus, the system is a tangible object and is novel and is statutory subject matter. Regarding claims 42-44, the claims specifically call for a recipient chat module <u>in a system</u> for sharing active content between a plurality of peers. Again, a tangible system is referenced in these claims, and thus, contain tangible subject matter and not merely a computer program. Therefore, claims 1-21 and 42-44 are allowable for at least the reasons cited herein.

<div align="center"><u>Claims Rejections Under 35 U.S.C. 102</u></div>

The Examiner rejected claims 1, 22 and 33 under 35 U.S.C. 102(a) as being anticipated by WIPO WO 03/050659 (*Gore*). Applicant respectfully traverses this rejection.

The Examiner misapplies the disclosure of *Gore* to read upon the elements of claim 1 of the present invention. For example, *Gore* discloses a system where each individual client computer includes a CD player or a DVD player, which it refers to as the media. *Gore* discloses

that a server is capable of synchronizing the operation of the media and that a separate chat window may be provided where users can communicate among one another. However, each individual user invokes the media locally on their respective client computers. The chat room of *Gore* is provided for communicating peripheral information regarding the operation of the media, and not the content of the media. *Gore* discloses that synchronization of the operations of the media on the local computers is performed via a server computer, to which the client computer sends information. That is, *Gore* is directed to a third entity (*i.e.,* a server) to moderate and synchronize the interaction between two chat modules on two separate computers. Accordingly, *Gore's* disclosure is in contrast to claim 1 of the present invention, which calls for a first application module for activating and outputting active content from the data file, and a first chat module for sending the information about the <u>active</u> content, and a second chat module for receiving an output of information about the <u>active</u> content on the second sender peer. *Gore* does not perform these steps.

Gore discloses a chat communication between that first user and the second user and a server using media information from the first user and other media information from the second user to synchronize the second user with the first user. *See* Figure 4, page 20, line 23 – page 22, line 6. The client operation described by *Gore* merely refers to operating the media locally and in gaining access to a server to provide server-specific information. The server is then prompted to provide the media information for logging purposes. Accordingly, in *Gore*, the chat module is not used to provide the data that is being cited by the Examiner as anticipating claim 1. In *Gore*, it is the server provides that the data. The Examiner erroneously makes the inference that simply because the second chat module receives some information, the first chat module *must* have sent the information to the second client. However, the Examiner is unable

to point to any evidence to support this conclusion. In fact, the Examiner does not even offer

arguments to support this position. *Gore* teaches that the server receives the media information

from the first and second clients and may synchronize the clients. *See Gore*, Fig. 4 (132-134).

A careful reading of Figure 4 reveals that the server in *Gore* stores the media information of the

clients. With respect to information about the <u>active</u> content, the Examiner states in the Final

Office Action that "[t]his information must be sent from the user's computer in order for the

other users to be able to view such information. As shown in Figure 12, the chat module is

clearly used to provide information about what the clients are listening to. See element 194."

See Final Office Action, p.28. However, the Examiner has overlooked the fact that while

certain data may be arriving at the receiving client computer, *Gore* **does not teach** that the first

chat module does the sending to the receiving client computer. In contrast to *Gore*, claim 1

calls for a first chat module, communicatively coupled to the first application module for sending

information about the active content.

Direct communications of *Gore* provide communications between the server and client to

provide the information regarding the media on the local computers. The chat module of *Gore*

displays this data from the server. There is no disclosure in *Gore* regarding providing

information about <u>active</u> content to the second chat module. In contrast to claims of the present

application, *Gore* is not directed to communications between a sender peer and a recipient peer,

where the sender peer comprises a first chat module and the recipient peer comprises a second

chat module; and wherein the second chat module receives and outputs information about the

active content that is active on the sender peer. *Gore* discloses no such subject matter. *Gore*

discloses communications with the server which provides information and synchronizing

processes to synchronize the operation of individual applications being performed on individual

clients. This disclosure does not anticipate all of the elements of claim 1. Therefore, *Gore* does not teach, disclose or suggest all of the elements of claim 1 of the present Application.

Similarly, claim 22 calls for activating media content from a data file at a sender peer and sending real time information about the active data content from the sender peer to a recipient peer through a chat network, and receiving and outputting information about the active media content of the recipient peer. Again, for at least those reasons cited above, *Gore* simply does not disclose the communications of information relating to the active media to the sender peer to the recipient peer via chat modules. The simple communications described in *Gore* along with the client to server communications, does not anticipate this subject matter. Therefore, claim 22 of the present invention, and its respective dependent claims, is also allowable for at least the reasons cited herein. Similarly, claim 33 calls for a computer program product that includes an apparatus for performing various types, such as activating content from the data file at a sender peer and sending information about the active media content in response to getting active content from the sender peer and receiving and outputting information about the active content at the recipient peer. Again, for reasons cited above, *Gore* does not disclose this communication between the sender peer and the recipient peer, as called for by claim 33 of the present invention. Thus, claim 33 of the present invention, and its respective dependent claims, is also allowable for at least the reasons cited herein. Claims 1, 22 and 33, and all their respective dependent claims, are allowable for at least the reasons cited herein.

The Examiner rejected claims 1-6, 8, 18-24, 27-35, 37-42 and 44 under 35 U.S.C. 102(e) as being anticipated by U.S. Publication 2003/0225834 (*Lee*). Applicant respectfully traverses this rejection.

Lee does not disclose or suggest all of the elements of independent claims 1, 22, 33, and 42 of the present invention *Lee* is directed to content sharing system to share content using multiple communication paths. The communication in *Lee* is between an inviter computer and an invitee computer. *Lee* discloses an "online message path" that is used to attempt to establish a separate communications path for content sharing. *See Lee*, page 7, ¶[0066]. *Lee* is explicit that the inviter computer attempts to set up a separate path for content sharing, and this path may be a "point-to-point tunneling protocol." *See Lee*, page 7, ¶¶[0064-0066]. The separate, second port used for content sharing session is "a second communication path" that is "defined between the identified port and the invitee computer." *See Lee*, page 7, ¶[0067]. However, *Lee* fails to disclose <u>a first chat module sending information</u> about the active content to a recipient peer. *Lee* is explicit in disclosing that an "online message service" with "small relatively small amount of bandwidth" is used in <u>setting up</u> the <u>separate</u> communication path for content sharing. *See Lee*, page 7, ¶[0066]. This is in contrast to the chat modules called for by claims of the present invention, which provides for sending and receiving information about the active content in a sender peer. Further, *Lee* does not disclose any type of real time communications with regards to media content. For at least these reasons, *Lee* does not teach, disclose or suggest all of the elements of claim 1 of the present invention. Further, claims 22 calls for real time information regarding media content through a chat network connection, which as described above, relate to subject matter that is not taught, disclosed or suggested by *Lee*. Claim 33, which calls for communications similar to claim 1 is also not taught, disclosed, or suggested by *Lee* for similar reasons. Claim 42 calls for a graphical user interface (GUI) for outputting content information from a sender peer upon receiving one or more unique identifiers based upon shared active content. *Lee* does not disclose any type of a GUI for outputting content information based upon

receiving unique identifiers relating to shared active content. Accordingly, claim 42 is also allowable.

Independent claims 1, 22, 33, and 42 are allowable for at least the reasons cited herein. Further, dependent claims 2-21, 23-32 and 43-44 are also allowable for at least the reasons cited herein.

Claim 2 is allowable for additional features recited therein. Claim 2, depending from claim 1, calls for the second chat module further comprising a client module for requesting a stream of the active content and the first chat module further comprises a server module for sending the stream of active content in response to the request. The Examiner's rejection fails because *Lee* fails to teach at least one of the claimed features. For example, *Lee* does not teach the claimed feature of <u>requesting a stream of the active content</u>. The Examiner argues this feature is taught by *Lee*. *See* Final Office Action, p.2. In particular, the Examiner argues that a dynamic download (streaming, according to the Examiner) performed by the receiving machine teaches this feature. *See id.; see also Lee,* ¶[0075]. *Lee,* however, teaches that a receiving machine may download a media file from a first machine, and that the receiving machine may begin to play the stored media file before the entire file is received. *See Lee,* ¶[0075]. This disclosure does not amount to subject matter that could anticipate the stream of active content using peer to peer communication of claim 1. In contrast to *Lee,* claim 1 of the present Application calls for <u>requesting a stream of the active content</u>. A <u>stream of **active** content</u>, for example, would be an audio file from the first machine *as it was being listened to* by a user at the first machine. In *Lee,* the file is played at some later time after it is received, which does not anticipate the stream of active content in claim 1. Therefore *Lee* does not, and cannot, teach the claimed feature of claim 2.

Additionally, claim 2 calls for comprises a server module for sending the <u>stream of active content</u> in response to the request. As discussed above with respect to the claimed feature of <u>requesting a stream of the active content</u>, *Lee* fails to teach or suggest such a feature. As such, *Lee* must also fail to teach a server module for sending the <u>stream of active content</u> in response to the request, as called for in claim 2.

For at least the aforementioned reasons, claim 2 is allowable. Claims 3-5 are also allowable for similar reasons.

Claims Rejections Under 35 U.S.C. 103

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication 2003/0225834 *(Lee)*. Applicant respectfully traverses this rejection.

The Examiner asserts that *Lee* makes claim 7 obvious because it would've have been allegedly obvious that the receiving peer would have a unique identifier to retrieve active content information from a content information database. Firstly, *Lee* fails to disclose an active content database. Secondly, the Examiner's argument that because the sending machine "knows" what tracks the receiving machine has stored, it does not need to send these tracks. The Examiner then concludes that thus, the receiving peer uses a unique identifier to identify the file to minimizing the amount of traffic. The Examiner fails to point to any evidence to support this assertion. This is improper hindsight reasoning to "find" obviousness when there is a lack of evidence to show it. Thirdly, as described above, all of the elements of claim 1, from which claim 7 ultimately depends, are not taught or suggested. The Examiner has failed to show a *prima facie* case of obviousness. Accordingly, all of the elements of claim 7 is not taught, disclosed or suggested by *Lee*.

Claims 9-11, 13-17, 25-26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lee* in view of U.S. Patent 7,080,030 *(Elgen)*. Applicant respectfully traverses this rejection.

Applicant respectfully asserts that *Lee, Elgen,* and/or their combination do not teach or disclose all of the elements of claim 1 of the present invention. In order to establish a prima facie case of obviousness, the Examiner must consider the following factors: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. MPEP § 2143 (2005) (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In making an obviousness rejection, it is <u>necessary</u> for the Examiner to <u>identify the reason why</u> a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. *KSR Int'l Co. v. Teleflex, Inc.*, at 14, No. 04-1350 (U.S. 2007). Applicant respectfully submits that the Examiner has not met this burden. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established in rejecting claims -11, 13-17, 25-26 and 36.

The Examiner uses *Elgen* to argue obviousness relating to supplements related to the active contents and/or content enhancement server of claims 9-11, 13-17, 25-26 and 36. Firstly, adding *Elgen* does not make for *Lee's* deficit relating to the supplements related to the active contents and/or content enhancement server. *Elgen* is directed to digital online communications. *Elgen* does not even mention chat modules except for a passing reference that lists a chat program among various applications that may reside in a computer. *Elgen* discloses a music database that may store information relating to the name of the song, the artists, etc., within the

music database, but does not disclose a content supplement database. The Examiner seems to argue that because the music database contains additional information, such as artist name, this suffices for a supplemental database as disclosed in the claims of the instant Application. However, *Elgen* fails to disclose such a supplemental database. Further, as show above, *Lee* does not disclose other elements of the independent claims from which 9-11, 13-17, 25-26 and 36 respectively. Still further, the Examiner failed to identify the reasons why those skilled in the art would combine *Lee* and *Elgen* in a manner provided in the claims 9-11, 13-17, 25-26 and 36. Accordingly, the Examiner failed to provide a *prima facie* case of obviousness of claims 9-11, 13-17, 25-26 and 36. Therefore, claims 9-11, 13-17, 25-26 and 36 are allowable for at least the reasons cited herein.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Lee* in view of U.S. Patent 6,385,596 *(Wiser)*. The Examiner also rejected claim 12 under 35 U.S.C. 103(a) as being unpatentable over *Lee* in view of *Elgen*, as applied to claim 9 and further in view of *Wiser*. Applicant respectfully traverses these rejections. Adding the preview disclosure of *Wiser* to the disclosure of *Lee* and *Elgen* would not make the elements of claims 43 and 12. The data streams called for by claims 12 and 43 are not made obvious by *Wiser, Lee* and/or *Elgen*. As described above, the underlying independent claims (1 and 42), from which claims 12 and 43 respectively depend are not made obvious by *Lee*, and *Wise* and/or *Elgen* do not make up for this deficit. Further, the Examiner has failed to identify the reasons why those skilled in the art would combine *Lee*, *Wiser* and *Elgen* in a manner provided in the claims 12 and 43. *KSR Int'l Co. v. Teleflex, Inc.*, at 14. Accordingly, the Examiner failed to provide a *prima facie* case of obviousness of claims 12 and 43. Therefore, claims 12 and 43are allowable for at least the reasons cited herein.

For at least the aforementioned reasons, claims 1-44 are allowable. For similar reasons, the remaining claims are also allowable.

Reconsideration of the present application is respectfully requested.

Applicant respectfully asserts that in light of the arguments provided throughout the prosecution of the present application, all claims of the present application are now allowable and, therefore, request that a Notice of Allowance be issued. Reconsideration of the present application is respectfully requested.
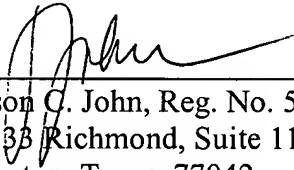
If for any reason the Examiner finds the application other than in condition for allowance, **the Examiner is respectfully requested to call the undersigned attorney** at the Houston, Texas telephone number (713) 934-4064 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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